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SMX 3104 (2000-108)
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit 1743

Application of Dales, et al.

Patent No. 6,759,014

Issued July 6, 2004

Confirmation No. 7959

For APPARATUS AND METHODS FOR PARALLEL PROCESSING OF MULTIPLE
REACTION MIXTURES

Examiner Arlen Soderquist

July 14, 2004

APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 CFR 1.705(d)

TO THE COMMISSIONER FOR PATENTS,

SIR:

Applicants respectfully request reconsideration of the patent term adjustment determination of six hundred and fifty-four (654) days in the Issue Notification dated June 17, 2004. Pursuant to 37 CFR 1.705(b)(2), Applicants submit the following statement of facts in support of this request.

According to §§ 1.702 and 1.703, the correct patent term adjustment should be seven hundred and nine (709) days.

The subject application was mailed on January 26, 2001. According to 37 C.F.R. §1.702(a) (1), a first notification under 35 U.S.C. §132 or a Notice of Allowance under 35 U.S.C. §151 was due fourteen (14) months from that date, March 26, 2002. In fact, the Notice of Allowance was mailed on March 4, 2004, seven hundred and nine (709) days past the fourteen (14) month due date. The Office calculates this portion of the adjustment correctly.

Included in the Notice of Allowance, the Examiner made the following explicit requirement of Applicants:

During a telephone conversation with Brian P. Klein on March 4, 2004 a provisional election was made without traverse to prosecute the invention of Group 1, claims 1-25. **Affirmation of this election must be made by applicant in replying to this Office action.**

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had no opportunity to affirm the election until after the Notice of Allowance was received by Applicants, several days after issuance of the Notice. Applying the rule as the Office has done, therefore, means that a verbal election associated with a Notice of Allowance automatically results in some loss of additional term. This is clearly unfair and contrary to the intent of the rule. Second, the affirmation of the previous election is merely a formality confirming the earlier decision to elect the allowed claims and does not slow prosecution. Here, the patent issued fifty-five (55) days later, which is no more time than if the issue fee had been filed alone. Third, an election affirmation is very similar to responding to Examiner's reasons for allowance, another paper that does not constitute a failure to engage in reasonable efforts to conclude prosecution.

Thus, Applicants respectfully request that the reduction of fifty-five (55) days (May 13, 2004 to July 6, 2004) be removed from the PTA calculation. This correction should bring the total patent term adjustment to seven hundred and nine (709) days.

There were no circumstances constituting a failure by the Applicants to engage in reasonable efforts to conclude processing or examination of this application as set forth in 37 CFR 1.704.

There is no terminal disclaimer in this case.

In light of the foregoing facts, Applicants respectfully request a patent term adjustment of seven hundred and nine (709) days. Please charge deposit account No. 50-0496 in the amount of \$200 to pay the fee required by 37 CFR §1.18(e). Please charge any underpayment or credit any overpayment to deposit account No. 50-0496.

Respectfully submitted,



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